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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,672	07/26/2001	John M. Surwillo	070191/320 (31-CD-6181)	7286
7590	06/22/2004			EXAMINER
Neal D. Marcus FOLEY & LARDNER One IBM Plaza 330 North Wabash Avenue, Suite 3300 Chicago, IL 60611-3608				OROPEZA, FRANCES P
			ART UNIT	PAPER NUMBER
			3762	
				DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/915,672	SURWILLO ET AL.
	Examiner Frances P. Oropeza	Art Unit 3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 3/30/04 (Amendment and RCE).
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-16,18 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) 29-34 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4-16,18 and 22-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. The Applicant's submission filed on 3/30/04 has been entered.

Election / Restriction

2. Claims 29-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/30/04.

The Applicant asserts claims 1 and 29 are not independent because "there is a clear relation between Claims 1 and 29-35 as each claim covers the preferred embodiment using similar terminology", noting "'an exercise stress test device" (claim 29) is a more narrow recitation of "an instrument" (claim 1)". The Applicant continues to assert "the Examiner must state that the inventions are "distinct" which, by reference to MPEP 802.01, means that the two set of claims in the application are novel an unobvious over each other". The Examiner disagrees. Claims 29-35 are properly restricted because the claiming of "'an exercise stress test device" (claim 29) versus "an

instrument" (claim 1) changes the scope of the claim and introduces the new limitation of "an exercise stress test device" not found in any of the previous independent claims, hence creating an independent or distinct invention. The restriction is deemed proper.

The Applicant's assumptions about the Examiner's reason for restriction, found on page 12 of the Supplement Amendment filed 3/30/04 are inaccurate. The Examiner's reasons for restriction are discussed in the previous paragraph.

Response to Amendment

3. The Applicant amended the claims to overcome the rejections of record, hence the rejections of record are withdrawn and a new rejection of record established in the subsequent paragraphs.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-7 and 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner is unable to find in the specification the limitation of the instrument being powered by an external power

source. It is noted in paragraph 0030 the power supply is a wall socket. New matter may not be introduced at this point in the prosecution. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. Claims 1, 15, 16, 18, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raines (US 6149587) in view of Begun et al. (US 5474090) and further in view of Nakamura (US 6380921).

Raines teaches a diagnostic system that comprises pulse wave monitors (col. 6 @ 31-59; col.17 @ 8-18). Figure 1 discloses an analyzing unit (12) comprising a table top (63), read as a work surface, a light source to light the work surface, a key pad (75) and a printer (79).

Raines discloses the claimed invention except the printing medium moving along the work surface (Claims 1, 8, 15, 22, 24 and 27).

Begun teaches the printing of monitored ECG data using a printing medium that moves across the work surface (30) for the purpose of producing strip charts that can be reviewed by medical personnel. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a printing medium that moves across the work surface in the Raines system in order to ensure there is a permanent record of the cardiac test for future reference (figure 1, col. 5 @ 61-66; col. 13 @ 17-22).

Modified Raines discloses the claimed invention except for a component for activating and deactivating the illuminating component (claims 1, 8, 15, 22 & 24), a deactivating component (claims 1, 8, 12-15, 22, 24 & 28), the illuminating component being an LED (claim 16), the computer program performing the illumination method (23), the predetermined time being 60 minutes (claim 23), and an on/off switch (claims 25 & 27).

Nakamura discloses an illuminated touch screen/ work area and teaches using the following elements, combinable for the reasons noted, to modify the instrument for monitoring cardiac characteristics as taught by Selker et al.:

- a switch (6), read as a component for activating and deactivating the illuminating component, for the purpose of controlling the illumination source in order to provide light for the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36),
- the illumination controller (13), read as the deactivating component for the illumination component, and illumination timer (15) for the purpose of turning off the lights during periods when the touch screen has not be used for a predetermined period of time in order to save the power (col. 4 @ 13-18; col. 5 @ 53-60),
- the illuminating component being an LED for the purpose of lighting the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36),

- the CPU (11) and associated computer program controls the illumination method for the purpose of automating the control of the lights to optimize the handling performance of the instrument and to prevent wasteful power consumption (col. 4 @ 1-3 and 48-54),
- the predetermined time being 60 minutes, for the purpose of providing sufficient time to review the results on the screen, yet not waste power or have the nuisance of having to re-illuminate the screen during the monitoring and data review process col. 4 @ 48-54). Absent any teaching of criticality or unexpected result for the specific time period, a 60 minute predetermined time period would have been an obvious design choice. It is also noted in the specification, paragraph 0033, "the predetermined period is preferably set to an hour but any desired length may be set", and
- an on/off switch (6), read as a component for activating and deactivating the illuminating component, for the purpose of controlling the illumination source in order to provide light for the touch screen in order to enable the user to use the instrument in dark environments (col. 1 @ 15-20 and 32-36).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raines (US 6149587) in view of Begun et al. (US 5474090) and further in view of Nakamura (US 6380921) and further in view of Polley et al. (US 5868487). As discussed in paragraph 5 of this action, modified Raines discloses the claimed invention except for the component for activating and deactivating being a toggle switch (claim 4).

Polley et al. teach computer work area lighting system using a toggle switch(es) (17, 18) for the purpose of activating and deactivating the illumination sources. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a toggle switch in the modified Raines system in order to provide the instrument operator with control over the illumination system so the optimum lighting configuration can be controlled by the instrument operator (col. 1 @ 17-25; col. 2 @ 44-64; col. 3 @ 21-27; col. 4 @ 3-28).

7. Claims 5-14, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raines (US 6149587) in view of Begun et al. (US 5474090) in view of Nakamura (US 6380921) and further in view of Nelms et al. (US 4365290). As discussed in paragraph 5 of this action, modified Raines discloses the claimed invention except for the keys being associated with an instruction (claim 5), a determining component to scan the keyboard and determine if a key has been pressed (claims 6, 8, 11, 22), and deactivating the illuminating component when a toggle key is pressed (claim 9).

Relative to the keys being associated with an instruction, Nelms et al. teach a computer system using keys (26) associated with parameters, read as an instructions, for the purpose of enabling selected activity sequences for the instrument. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used keys associated with an instruction in the modified Raines system in order to

effectively and efficiently accomplish multi-component tasks with the push of a single button (col. 4 @ 1-10; col. 10 @ 51-62).

Relative to a determining component to scanning the keyboard to determine if a key has been pressed, Nelms et al. teach a computer system using a decoder for the purpose of determining which keys have been pressed by the instrument operator. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a decoder in the modified Raines system in order to provide the instrument with a component to enable communication between the operator and the computer system so the desired testing and monitoring is accomplished (col. 5 @ 55-65).

Relative the toggle key, Nelms et al. teach a computer system using a toggle key (22-2) for the purpose of activating and deactivating power. It would have been an obvious design choice to use a toggle key to activate and deactivate power to an illumination means. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used a toggle key to activate and deactivate the illumination component in the modified Raines system in order to have a convenient means for controlling the light associated with the instrument so the operator can effectively conduct the monitoring and evaluation of the patient (col. 8 @ 20-22).

Specification

8. The amendment filed 3/30/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment

shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: As to claims 1, 4-7 and 27-28, the Examiner is unable to find in the specification the limitation of the instrument being powered by an external power source. It is noted in paragraph 0030 the power supply is a wall socket. The Applicant is required to cancel the new matter in the reply to this Office Action.

Statutory Basis

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Friday from 9 a.m. to 5:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

APD
6/17/04

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